

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: A9845

Donald Edward BENSON, et al.

Appln. No.: 10/758,501

Group Art Unit: 2161

Confirmation No.: 6340

Examiner: Brent S. STACE

Filed: January 16, 2004

For: METHOD AND APPARATUS FOR ENTITY REMOVAL FROM A CONTENT  
MANAGEMENT SOLUTION IMPLEMENTING TIME-BASED FLAGGING FOR  
CERTAINTY IN A RELATIONAL DATABASE ENVIRONMENT

**REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits  
this Reply Brief in response to the Examiner's Answer dated December 20, 2008. Entry of this  
Reply Brief is respectfully requested.

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REPLY BRIEF UNDER 37 C.F.R. § 41.41  
U.S. Appln. No.: 10/758,501

Attorney Docket No.: A9845

**STATUS OF CLAIMS**

Claims 1-4 and 7-20 are pending in this application. Claims 1-4 and 7-20 are rejected.

Claims 5 and 6 are canceled. No claims are currently allowed.

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

(A) Whether claims 1-4, 7, 9-16, and 18-20 recite patentable subject matter under 35 U.S.C. § 103(a) over applied non-patented document of Ten Minute Guide to Windows NT Workstation 4.0 (hereinafter “Windows”) in view of *Balabine et al.* (U.S. Patent No. 5,937,406).

(B) Whether claims 8 and 17 recite patentable subject matter under 35 U.S.C. § 103(a) over applied non-patented document of Ten Minute Guide to Windows NT Workstation 4.0 (hereinafter “Windows”) in view of *Balabine et al.* (U.S. Patent No. 5,937,406), and further in view of Mac OS X: The Missing Manual (hereinafter “MacOSX”).

### **ARGUMENT**

In this Reply Brief, Appellant addresses below certain points raised in the Examiner's Answer as mailed on December 20, 2007.

**I. The Examiner errs in collapsing two separate and distinct claim features into a single feature**

Each of the independent claims, in some variation, recites, *inter alia*, an item, and an object associated with the item. In the Examiner's Answer dated December 20, 2007, the Examiner asserts that the claims do not limit what the claimed item or object is, and as such, almost anything can apply (*see* page 15 of the Examiner's Answer). The Examiner further argues that the items could even be items on a grocery shelf (*see* page 15 of the Examiner's Answer). The Examiner also asserts that both of the terms, an item and an object associated with an item, may be interpreted to refer to two different files on a computer (*see* page 15 of the Examiner's Answer).

Appellant respectfully points out that the Examiner ignores the fact that an item and an object associated with the item are clearly separate and distinct claim features having separate and distinct meanings. Accordingly, Appellant respectfully submits that a person of ordinary skill in the art would clearly understand that an item cannot mean the same thing as an object associated with the item and accordingly, both claim features cannot refer identically to files on a computer, in a generic sense. Thus, Appellant respectfully submits that an item is not identical to an object associated with the item.

The Examiner points to the following citation excerpted from *Windows*:

**Confirm File Replace** If you attempt to copy a file or folder to a location in which a file or folder with the same name exists, Windows NT lets you know with a message that displays the selected file's and the original file's size and creation or last modification date. Click Yes to replace the file, or click No to stop the process. (underlining added)

Consequently, Appellant respectfully disagrees with the Examiner's assertion that one of the files (e.g., the file to be copied) is the same as the item and that the other file (e.g., the pre-existing file in the destination location) is the same as the object associated with the item.

Appellant respectfully asserts that the item and the object associated with the item are unique features, and the generic files pointed to by the Examiner cannot be the same as both the item and the object associated with the item.

II. The cited references fail to teach or suggest completing the request based on the version of the item and the version of the object

With respect to claims 1-4, 7-17, and 20, the Examiner alleges that *Windows* teaches completing the request based on the version of the item and the version of the object, as recited, *inter alia* and in some variation, in the claims.

Appellant respectfully disagrees. Instead of teaching completing the request based on the version of the item and the version of the object, according to *Windows*, the user is presented with a message which lets the user know the selected file's and the original file's size and creation or last modification date. The user may then click Yes to replace the file or No to stop the process.

Accordingly, the request is completed based on the user's click on Yes (in which case the file is replaced), or No (in which case the process is stopped). The file size and creation or last

modification date are merely displayed as information for the user. The request is not completed based on the file size and creation or last modification date; rather, the file is replaced if the user clicks Yes and the process is stopped if the user clicks No.

Accordingly, Appellant respectfully submits that *Windows* neither teaches nor suggests completing the request based on the version of the item and the version of the object.

III. The cited references fail to teach or suggest selectively deleting the item and the at least one associated object based on whether the first age of the item is greater than or equal to the second age of the at least one associated object

With respect to claims 18 and 19, the Examiner alleges that *Windows* teaches selectively deleting the item and the at least one associated object based on whether the first age of the item is greater than or equal to the second age of the at least one associated object, as recited, *inter alia* and in some variation, in the claims.

Appellant respectfully disagrees. As noted previously, the user is presented with a message which lets the user know the selected file's and the original file's size and creation or modification date. The user may then click Yes to replace the file or No to stop the process.

Accordingly, instead of teaching selectively deleting the item and the at least one associated object based on whether the first age of the item is greater than or equal to the second age of the at least one associated object, the file is replaced if the user clicks on Yes, or, the file is not replaced if the user clicks on No.

Thus, Appellant respectfully submits that *Windows* neither teaches nor suggests selectively deleting the item and the at least one associated object based on whether the first age of the item is greater than or equal to the second age of the at least one associated object.

IV. The Examiner has failed to persuasively show an apparent reason as to why an artisan of ordinary skill, at the time of the invention, would have found it obvious to combine the *Windows* and *Balabine* references

Appellant respectfully notes that the initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Rikckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). In *KSR International Co. v. Teleflex Inc.*, the Supreme Court held that the prior art relied upon, or the knowledge generally available in the art at the time of the invention, must support some apparent reason as to why an artisan of ordinary skill would have found it obvious to modify a reference or to combine references, and this reason should be made explicit. 127 S. Ct. 1727 (U.S. 2007).

Further explaining this requirement, the *KSR* court held,

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. 127 S. Ct. at 1741.

Appellant respectfully submits that the reasons for the combination proffered by the Examiner are not “reason[s] that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does,”<sup>1</sup> but rather are merely

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<sup>1</sup> *Id.*

general, non-specific statements regarding both inventions being directed towards file manipulation operations (*see* page 6 of the Examiner's Answer). These highly general statements cannot satisfy the "apparent reason" that *KSR* requires be explicitly identified.

The Examiner has failed to identify any problem or defect in the references that would prompt a person of ordinary skill in the art, at the time of the invention, to modify the references in the manner described by the Examiner.

Furthermore, the Examiner has failed to identify any teaching found in the references as to why it would have been desirable to modify. The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of invention having the teachings of Balabine and *Windows* before him/her to take the database accessing techniques from Balabine and install it into the invention of *Windows*, thereby offering the obvious advantage of sharing data seamlessly with both database-aware and database-unaware applications (*see* page 6 of the Examiner's Answer). But Balabine already teaches sharing data seamlessly with both database-aware and database-unaware applications (*see* col. 3, lines 49-51 of Balabine), thus it is not necessary to combine Balabine and *Windows* to achieve this seamless data sharing. Furthermore, Appellant respectfully submits that the Examiner fails to identify any reason why the teachings of *Windows* cited by the Examiner, related to copying files or folders to a location in which a file or folder with the same name exists, help enable sharing data seamlessly with both database-aware and database-unaware applications. Appellant respectfully submits that no such reason would be apparent to a person of ordinary skill in the art.



Accordingly, Appellant respectfully submits that an apparent reason to modify the references in the manner claimed by the Examiner is simply not present in the cited references, and thus the claims are not obvious over the cited combination of references.

Appellant further submits that the modifications described by the Examiner are not merely a simple substitution of elements with equivalent functions, nor are they a matter of routine design choice. Moreover, the Examiner has not offered any evidence showing that the claimed invention could simply be created by picking and choosing various elements from disparate references; the Examiner has not shown that this combination would be possible without a significant reengineering of the system.

Instead, the combination, rather than being obvious to a person of ordinary skill in the art at the time of the invention, is a product of improper hindsight. The *KSR* court warned that “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.” 127 S. Ct. at 1743. Appellant respectfully submits that the Examiner’s allegations that it would have been obvious to combine the references are a product of improper hindsight bias.

Accordingly, at least for the above reasons, Appellant respectfully submits that the Examiner has not shown *prima facie* obviousness and that it clearly would not have been obvious for a person of ordinary skill in the art to combine the references in order to arrive at the claimed invention.

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**CONCLUSION**

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

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**23373**

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